

REMARKS

1. In response to the Office Action mailed November 17, 2007, Applicant respectfully requests reconsideration. Claims 1-4, 6-9, 12-15 were last presented for examination. In the outstanding Office Action, claims 1, 3, 4, 6-9, 13 and 14 were rejected. By the foregoing Amendments, claims 1 and 8 have been amended to address the rejection under 35 U.S.C. § 101 as detailed below and not to limit its scope. Claim 16 has been added no claims have been canceled. No new matter has been added. Upon entry of this paper, claims 1-4, 6-9 and 12-16 will be pending in this application. Of these thirteen (13) claims, 5 claims (claims 1, 2, 12, 15 and 16) are independent.

Priority Claim

2. Applicant notes with appreciation the Examiner's acknowledgement of foreign priority under 35 U.S.C. §119.

Claim Rejections under §101

3. Claims 1, 3, 4, 6-9, 13, and 14 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Specifically, the Office Action states that, by reciting "said orthodontic fixture is connected to an appliance configured to facilitate distracting the jaw bone and supported by one of at least teeth and adjacent static fixtures", "the claims appear to recite part of the human body alternatively in connection with the structure of the claimed invention." (See, Applicant's independent claim 1, above; Office Action, pg. 2, ¶ 2.) The claims have been amended to recite "wherein said orthodontic fixture is connected to an appliance configured to facilitate distracting the jaw bone and ***configured to be supported by*** one of at least a tooth and an adjacent static fixture", thereby overcoming this rejection. (See, Applicant's independent claim 1, as amended, above; emphasis added.) In light of the above amendments, Applicant respectfully requests that the rejections be reconsidered and that they be withdrawn.

Claim Rejections under §102

4. Claims 1, 3, 4, 6 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. 2002/0081553 to Tramonte (hereinafter, "Tramonte"). The Office Action asserts that Tramonte teaches or suggests all features of Applicant's claimed invention,

including the feature of a “*fixture... connected to an appliance being supported by adjacent static fixture* and the second part protrudes through the appliance.” (See, Office Action, pg. 3, ¶ 4.) Applicant respectfully disagrees.

5. In making the above assertion, the Office Action does not provide any support for finding Applicant’s claimed feature of a “fixture... connected to an appliance being supported by adjacent static fixture” in Tramonte. Other than the statement that such a feature is found in Tramonte, the Office Action fails to identify where in Tramonte such a teaching can be found. In fact, Tramonte does not teach or suggest such a feature. Tramonte is directed to a endosseous dental implant 1 comprising various features and having a superstructure 4 connected to a head portion 3. Tramonte does not teach or suggest an orthodontic fixture connected to an appliance where the appliance is configured to be “supported by... one of at least a tooth and an adjacent static fixture.” (See, Tramonte, Abstract.) Furthermore, the Office Action expressly admits that “Tramonte does not explicitly show the fixture connected to the appliance to facilitate distracting the jaw bone.” (See, Office Action, pg. 3, ¶ 6.) Accordingly, these rejections of claims 1, 3, 4, 6 and 7 under 35 U.S.C. 102(e) are improper, and should be reconsidered and withdrawn.

Claim Rejections under §103

6. Claims 1, 3, 4, and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tramonte in view of DE19848599 to Kirsch, *et al.* (“Kirsch”). The Office Action states that Tramonte substantially discloses Applicant’s invention as claimed, but admits that “Tramonte does not explicitly show the fixture connected to the appliance to facilitate distracting the jaw bone.” (See, Office Action, pg. 3, ¶ 6.) The Office Action relies on Kirsch to teach that which is missing from Tramonte. According to the Office Action, “Kirsch *et al.* teach[es] a fixture connected to a jaw bone distraction appliance... [and] *it would have been obvious* to one having ordinary skill in the art... *to modify the fixture of Tramonte* to include the appliance of Kirsch *et al. in order to distract the jaw bone.*” (See, Office Action, pg. 4.) The Office Action provides no other rationale in support of the proposed combination.

7. This rejection of independent claim 1 is *prima facie* improper because it provides no appropriate basis for combining Tramonte and Kirsch. As recently stated by the Supreme

Court, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently known in the prior art.” (*See KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).) Moreover, the Supreme Court recognized in *KSR* that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**” (*See KSR*, 127 S.Ct. at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed. 2006).)

8. Applicant submits that the Office Action completely fails to satisfy these legal obligations in the rejection of claim 1 under 35 U.S.C. §103. In particular, the Office Action states what has been viewed as circumspect by the Supreme Court, and has merely provided a conclusory and unsupported statement to justify the proposed combination.

9. As noted above, the Office Action states that Tramonte teaches all elements of claim 1, except for a “fixture connected to the appliance to facilitate distracting the jaw bone.” (*See*, Office Action, pg. 3, ¶ 6.) In order to remedy this admitted deficiency in Tramonte, the Office Action relies on Kirsch to teach the missing claim element. The reason provided in the Office Action for combining Tramonte and Kirsch is that it would have been obvious to one having ordinary skill in the art “to modify the fixture of Tramonte to include the appliance of Kirsch *et al.* in order to distract the jaw bone.” (*See*, Office Action, pg. 4.) However, nothing in Tramonte suggests that distracting the jaw bone is desirable. In fact, as detailed below, the opposite appears to be true. Not only is the proffered justification in the Office Action for the combination a mere conclusory statement, but, as explained below, this statement also lacks any “**rational underpinning**” to support the obviousness of the proposed combination as required by the Supreme Court. (*See KSR.*, 127 S.Ct. at 1741; emphasis added.)

10. Tramonte is directed to “a dental endosseous implant” configured to be placed in a bone hole having a reduced diameter, which allows the implant of Tramonte to be “**self-bearing and... immediately operative.**” (*See*, Tramonte, ¶ 18.) In addition to describing various functions of endosseous implants, Tramonte describes various problems being mitigated by the implant it describes in the application. For example, Tramonte states a problem of “breaking of the connecting neck between the head portion and the anchoring portion” or a weakening at that point during everyday use. (*See*, Tramonte, ¶ 23.) To mitigate this problem, Tramonte states

that “grip means 7 comprises at least two and preferably four holes 8... so that, by an appropriate operating tool, rotation of the anchoring portion can be carried out... Practically, even in the case of breakage of the intermediate neck 6... from the rest of the rest of the implant, said grip means 7 [via the four holes 8] can be acted upon by an appropriate tool and extraction of the anchoring portion 2 can be carried out.” (See, Tramonte, ¶ 46, 47 and 49.) As will be apparent to persons having skill in the art, Tramonte is describing an implant which, among other things, is intended to be implanted into a fixed bone, and not a bone being distracted or transported.

11. Thus, the above conclusory statement provided in the Office Action clearly does not provide a rational underpinning to explain the proposed combination. First, the Office Action’s statement that it would be desirable to modify the implant of Tramonte to distract the jaw bone is totally unfounded. As explained above, the implant of Tramonte is clearly meant to be placed in a small-diameter hole and be “self-bearing and... immediately operable” as a load-bearing implant. As one of skill in the art would appreciate, in order to be bear weight, so as to be “self bearing”, the implant would require that the bone in which it is placed be stable and not subject to “distractive”. Therefore, it is unreasonable to assert that one of ordinary skill in the art would seek to “modify the fixture of Tramonte to include the appliance of Kirsch *et al.* in order to distract the jaw bone” as suggested by the Examiner.

12. Second, the Office Action attempts to justify the alleged combination by stating that it would have been obvious to modify the fixture of Tramonte “in order to distract the jaw bone.” (See, Office Action, pg. 4.) In making this assertion, the Office Action does not provide any support other than the conclusory statement itself. The above cited case law makes it extremely clear that without a clear, articulated reason having some rational underpinning to explain the proposed combination, an obviousness rejection under 35 U.S.C. §103 cannot be maintained. (See *KSR.*, 127 S.Ct. at 1741.) Because, as explained above, the Office Action fails to provide any rational underpinning to justify the proposed combination, the proposed combination of Tramonte and Kirsch is *prima facie* improper. As such, Applicant requests that the rejection of claim 1 under 35 U.S.C. §103 be reconsidered, and that it be withdrawn.

Dependent claims

13. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the art of record. Accordingly, Applicant respectfully asserts that the dependent claims are also allowable over the art of record.

New Claims

14. Applicant submits that support for new claim 16 can be found in the originally filed application, including its text, figures and claims. No new matter has been added. For the reasons discussed above with reference to claim 1, Applicant submits that new claim 16 is non-obvious in light of the art of record.

Conclusion

15. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

16. Applicants reserve the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application. Any cancellations and amendments of above claims, therefore, are not to be construed as an admission regarding the patentability of any claims and Applicant reserves the right to pursue such claims in a continuation or divisional application.

17. In the event that the examiner believes that an interview would serve to advance the prosecution of this application, the undersigned is available at the number noted below.

18. Please charge any fees do with this response to our Deposit Account Number 22-0185, under Order Number 21547-00298-US1 from which the undersigned is authorized to draw.

Dated: _____

Respectfully submitted,

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